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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,371	10/11/2005	Stephen Hugh Freestone	FHW-141US	3015
959 7590 10/04/2007 LAHIVE & COCKFIELD, LLP ONE POST OFFICE SQUARE BOSTON, MA 02109-2127			EXAMINER ABRAHAM, TANIA	
			ART UNIT 3636	PAPER NUMBER
			MAIL DATE 10/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/530,371

Applicant(s)

FREESTONE, STEPHEN HUGH

Examiner

Tania Abraham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☒ Claim(s) 24-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "flap" (of claims 13-15) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 19, 21, and 24 are objected to because of the following:
- Claim 19 recites "framework" in line 3. In order to maintain consistency throughout the claims, "framework" should be changed to "frame".
 - Claim 21 recites "further comprises with one or more" in line 2. In light of the preceding sentence structure, it seems the term "with" should be deleted.
 - Claim 24 recites "is resiliency biased" in line 3. In light of the sentence structure, it seems the limitation should recite "resiliently biased".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1, 8 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 1 recites the limitation "a support strut" in lines 12-13. In light of previous recitations defining a main support strut and additional support struts (in lines 2-3 of this claim), this recitation does not particularly point out whether the "a support strut" is one of the previously recited struts or a new and different type of strut. Consequently, the recitation "a strut" in claim 8, line 2 is also indefinite.

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6. Claim 15 contains the trademark/trade name Velcro. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a hook and loop fastener and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 8-11, 16-19, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Grandjean ('871). Grandjean shows structure as claimed including a main support strut 2a and a plurality of additional support struts 2 that are connected to the frame (3-3b, 36, 37) by living hinges 38; and a handle 43 hinged to the main support strut by a pivot 15. Regarding claims 16 and 17, while Grandjean does not explicitly disclose the permeability or the opacity of the sheet material, these

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characteristics are determined to be present in the invention based on the umbrella being structured to provide shelter from the rain or sun (pg. 1, lines 26-33).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-5, 12, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grandjean in view of King ('281). Grandjean shows structure as claimed with the exception of a cap, a dome shape, and a support strut locking mechanism. Similar to Grandjean's umbrella, King shows a frame including a main support strut 15 and additional support struts 4 that extend circumferentially about a vertical axis into an open umbrella configuration. While having a cap disposed on the central axis of an umbrella canopy, for additional securing and support of the canopy struts, is conventional and well-known in the art by the time of this invention, King shows the structural detail of his cap 1 including a plug 3 received in a socket formed in the cap. King also shows his struts structured to provide the traditional dome shape of an umbrella, which maximizes the protected space under the umbrella canopy, when in its open configuration. King's apparatus includes a locking mechanism which fixes the main support strut 15 to one of the additional support struts 16 by any suitable fastening device (pg. 2, lines 3-9). So it would have been obvious to a person having ordinary

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skill in the art at the time of invention to modify Grandjean's frame (3-3b) with King's cap in order to improve the support provided to the support struts. It also would have been obvious to a person skilled in the art to modify Grandjean's struts with: a locking mechanism, as taught by King, in order to maintain the open configuration of the umbrella especially during use; and segmented struts, as taught by King, in order to achieve the traditional umbrella dome shape which provides more shelter space under the umbrella canopy.

11. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grandjean in view of Good. Grandjean shows structure as claimed with the exception of a plastic frame. Good shows a frame having radially extending support struts made entirely of polypropylene, which reduces the expense of the making the apparatus. As such, it would have been obvious to a person of ordinary skill in the art at the time of invention to comprise Grandjean's frame of plastic material, as taught by Good, in order to provide an inexpensive frame.

12. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grandjean in view of Vogt. Grandjean shows structure as claimed with the exception of a flap. Vogt shows a frame including a main support strut and additional support struts that extend circumferentially about a vertical axis into an open umbrella configuration, with a sheet material having a flap at each end; wherein the flaps are fixed together via a support shaft by means of a hook and loop fastener (fig. 4). It would have been obvious to a person of ordinary skill in the art at the time of invention to modify Grandjean's sheet material with a flap and fastener, as taught by Vogt, in order to

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sufficiently seal the sheet material in its open configuration for maximum protection from rain.

13. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grandjean in view of Chang. Grandjean shows structure as claimed with the exception of a detachable handle 50 (fig. 18). Chang provides a detachable handle for easy disassembly to allow for replacement of the handle (col. 3: 55-58). So it would have been obvious to a person of ordinary skill in the art at the time of invention to modify Grandjean's umbrella with a removable handle, as taught by Chang, in order to provide a handle that can be easily replaced according to the user's preference.

Allowable Subject Matter

14. Claims 24-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania Abraham whose telephone number is 571-272-2635. The examiner can normally be reached on Monday - Friday, 8:00am - 4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Dunn can be reached on 571-272-6670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tania Abraham
September 27, 2007



DAVID DUNN
SUPERVISORY PATENT EXAMINER